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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,155	01/21/2004	James R. Combes	D/A0A23DD	4954

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,155

Applicant(s)

COMBES ET AL.

Examiner

William P. Fletcher III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,15,18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-14,16,17 and 20-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/21/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application is a DIV of 10/350,534, filed 01/23/2003, now US 6,743,559 B2, which is a DIV of 09/723,911, filed 11/28/2000, now US 6,673,501 B1.
2. Claims 1-29 are pending.

Election/Restrictions

3. Applicant's election with traverse of the following species: for the polyester resin, copoly(propylene-diethylene-terephthalate)-copoly(propylene-diethylene-5-sulfoisophthalate); and, for the polypyrrole resin, a p-toluene sulfonate dopant, in the reply filed on 02/20/2006 is acknowledged. The traversal is on the ground(s) that "all of the species...can be examined without undue burden." This is not found persuasive because the election of species requirement mailed 01/19/2006 was made on the grounds that these species are patentably distinct, which is *prima facie* evidence of undue burden. Applicant has not addressed the examiner's reason for requiring an election of species or provided any evidence or reasoning in support of their position that there is no undue burden. Further, as noted in the prior action, in order to have adequately traversed on the more appropriate ground that the species are not patentably distinct, applicant should have submitted evidence or identified such evidence now of record showing the species to be obvious variants or clearly admitted on the record that this is the case.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 4, 5, 15, 18, and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 02/20/2006.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 01/21/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

6. The drawings were received on 01/21/2004. These drawings are accepted by the examiner.

Specification

7. The abstract of the disclosure is objected to because it does not recite any process steps. Correction is required. See MPEP § 608.01(b).

8. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

9. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

10. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

11. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: PROCESS FOR DEPOSITING MARKING MATERIAL ONTO SUBSTRATE, SAID MARKING MATERIAL COMPRISING TONER PARTICLES COMPRISING POLYESTER RESIN AND POLYPYRROLE.

12. The use numerous trademarks has been noted in this application. Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

13. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 1 recites an average particle diameter of no more than about 10 microns, while claim 2 recites an average particle diameter of no more than about 13 microns. The latter recitation is broader than the former and thus does not further limit the parent claim.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 1-3, 6-9, 16, 17, and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peeters et al. (US 6,328,409 B1) in view of JP 03-100561. Both of these

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references were cited in the IDS filed 01/21/2004, including an English-language translation of the JP document.

17. Peeters teaches all of the ballistic aerosol process limitation recited in these claims [abstract and 2:44-3:20].

While Peeters teaches some of the specific physical properties of the marking material including particle size, etc. [13:14-15:24] and while the reference teaches that the marking material may be a toner [3:28-33], this reference is silent with respect to the particular toner composition and, consequently, does not teach the particular toner composition recited in these claims. Because this reference is silent with respect to the toner composition, one of ordinary skill would have looked to the prior art to find a suitable toner composition.

As detailed at length in the record of parent 10/350,534 (incorporated by reference herein), JP '561 teaches applicant's claimed toner.

It would have been obvious to one of ordinary skill in the art to modify the process of Peeters so as to apply, as the toner marking material, the toner of JP '561. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully applying the toner marking material.

18. With respect to properties of the toner such as diameter, size distribution, concentration, and bulk conductivity, it is the examiner's position that these are all result-effective variables effecting the fluid and coating characteristics of the toner composition and may all be readily adjusted by the skilled artisan. Consequently, absent clear and convincing evidence of unexpected results demonstrating the criticality of the claimed diameter, size distribution,

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concentration, and bulk conductivity, it would have been obvious to one of ordinary skill in the art to optimize these result-effective variables by routine experimentation.

19. **Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peeters et al. and JP '561, as applied to claim 1 above, and further in view of Patel et al. (US 5,403,693 A).**

20. The teaching of Peeters and JP '561 is detailed above.

Neither of these references teach the particular emulsion aggregation process recited in these claims.

As detailed at length in the record of parent 10/350,534 (incorporated by reference herein), Patel teaches applicant's claimed emulsion aggregation process.

It would have been obvious to one of ordinary skill in the art to modify the process of Peeters in view of JP '561 so as to prepare the toner marking material according to the emulsion aggregation process of Patel. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully providing the toner marking material.

21. **Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peeters et al. and JP '561, as applied to claim 1 above, and further in view of Sacripante et al. (US 5,348,832 A).**

22. The teaching of Peeters and JP '561 is detailed above.

Neither of these references teach the particular polypyrrole recited in these claims.

As detailed at length in the record of parent 10/350,534 (incorporated by reference herein), Sacripante teaches coating a polyester toner particle with the claimed polypyrrole.

It would have been obvious to one of ordinary skill in the art to modify the process of Peeters in view of JP '561 so as to prepare the toner marking material by coating with the polypyrrole of Sacripante. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully providing the toner marking material.

Conclusion

23. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

04/14/2006



William Phillip Fletcher III
Patent Examiner (PSA), USPTO
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